

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
MBHB Docket No. 08-727-US-CON

In the Application of:)	
)	Examiner: George A. Bugg
John Miller, et al.)	
)	
App Serial No.: 10/824,962)	Group Art Unit: 2612
)	
Filing Date: April 15, 2004)	
)	Confirmation No.: 7469
For: System for Dynamically Pushing)	
Information to a User Utilizing Global)	
Positioning System)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO WITHDRAW HOLDING OF
ABANDONMENT UNDER 37 C.F.R. § 1.181(a)

Applicant respectfully requests the Office withdraw the abandonment of the instant application due to failure of the Office to provide Applicant with proper notice of an outstanding final office action, as directed by M.P.E.P. § 711.03(c)(I)(A) (discussing petitions to withdraw a holding of abandonment based on Applicant's failure to receive an office action). *See also Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971).

In particular, the Office failed to send Applicant's representatives a copy of the Final Office Action mailed on December 22, 2008 ("the Final Office Action"). A review of the Image File Wrapper on PAIR for the instant application indicates that the Office appears to have inadvertently failed to process a power of attorney filed on September 18, 2008 -- well before the mailing date of the Final Office Action. Additionally, Applicant's representatives filed a response to a non-final office action more than three months before the Office sent notification of the Final Office Action, providing further indication of the Applicants' appointment of new Counsel. Based on the inadvertent failure to process the power of attorney, the attorneys of

record were not informed of the outstanding final office action until after the instant application went abandoned.

On September 18, 2008, Applicant filed a power of attorney form PTO/SB/80 (“the POA”) and a statement under 37 C.F.R. § 3.73(b) with the Office. A copy of the POA, the statement under 37 C.F.R. § 3.73(b), and the corresponding filing receipt are attached as EXHIBIT A. The POA indicates that Applicant “hereby appoint[s] [p]ractitioners associated with the Customer Number 20306 ... as attorney(s) or agent(s) to represent the undersigned before the United States Patent and Trademark Office (USPTO)....” EXHIBIT A, p. 3. The POA also requested that the Office “change the correspondence address for the application identified in the attached statement under 37 CFR 3.73(b) to [t]he address associated with Customer Number 20306....” EXHIBIT A, p. 3. The statement under 37 CFR 3.73(b) indicated Applicant’s ownership of the instant application. *See* EXHIBIT A, pp. 4 (3.73(b) statement for U.S. Pat. App. No. 10/824,962 – the instant application -- refers to “attached appendix, line 3”) and 6 (line 3 has reel/frame data for U.S. Pat. App. No. 10/824,962).

To indicate the correspondence address associated with Customer Number 20306, a recent printout from PAIR of the details of Customer Number 20306 is provided as EXHIBIT B. Specifically, the Correspondence Address for Customer Number 20306 is shown on page 1 of EXHIBIT B as:

McDonnell Boehnen Hulbert & Berghoff LLP (“MBHB”)
300 S. Wacker Drive
32ND Floor
Chicago IL 60606
United States.

On September 22, 2008 – 4 days after the POA was filed – Applicant’s representatives filed a response to a non-final office action mailed April 21, 2008 (“the Non-Final Office Action”) for the instant application. The first and last pages of the response, along with the corresponding filing receipt, are included as EXHIBIT C. The top of first page of EXHIBIT C refers to “**MBHB** Docket No.: 08-727-US-CON” and indicates the response was directed for the instant application (emphasis added). EXHIBIT C, p. 1. The last page of the response indicates the response was filed by “Jeffrey P. Armstrong” of “McDonnell Boehnen Hulbert & Berghoff LLP” or MBHB. EXHIBIT C, p. 2. The filing receipt indicates that “Jeffrey Armstrong” was

the filer for the response. EXHIBIT C, p. 3. Thus, the response filed on September 22, 2008 to the Non-Final Office Action was filed by MBHB.

On December 22, 2008 – 3 months and 4 days after the POA was filed – the Office mailed the Final Office Action. A copy of the Final Office Action is attached as EXHIBIT D. The first page of the Final Office Action indicates a customer number of 23623 (shown in small numbers just above the mailing address). EXHIBIT D, p. 1.

The mailing address shown on the Final Office Action is:

AMIN, TUROCY & CALVIN, LLP (“Prior Counsel”)

127 Public Square

57th Floor, Key Tower

CLEVELAND, OH 44114.

EXHIBIT D, p. 1. The Address of Prior Counsel is not the address associated with MBHB and the customer number of Prior Counsel is not 20306.

The statutory period to reply to the Final Office Action was six months. 37 C.F.R. § 1.134 and EXHIBIT D, p. 2. June 22, 2009 is the date six months after the mailing date of the Final Office Action. According to 37 C.F.R. § 1.135(a), “[i]f an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.” As no response was filed to the Final Office Action prior to June 22, 2009, the Application went abandoned as of that date.

On July 30, 2009 – 9 months and 12 days after the POA was filed – the Office mailed a notice of abandonment. A copy of the notice of abandonment is attached as EXHIBIT E. The customer number and mailing address shown on the notice of abandonment are those of Prior Counsel. EXHIBIT E, p. 1.

EXHIBIT F shows a printout from PAIR of the Address & Attorney/Agent of Record for the instant application as of September 11, 2009, still listing the address of Prior Counsel. EXHIBIT F, p. 1. Thus, as of September 11, 2009, Applicant believes the Office still has inadvertently failed to process the POA filed almost a year prior on September 18, 2008.

Based on the evidence and reasons discussed above, Applicant submits the Office inadvertently failed to process the POA. The Office additionally appears to have inadvertently disregarded that Applicant’s representatives filed a response to the Non-Final Office Action, as indicated in EXHIBIT C, prior to the mailing date of the Final Office Action. Even though it

appears the Office had not yet processed the POA by the mailing date of the Final Office Action, the Office could have looked to the response to the Non-Final Office Action to aid determination of the mailing address for the Final Office Action.

Based on that processing error, notice of the Final Office Action was not received by Applicant's representatives until after the instant application was abandoned. As Applicant was ineffectively notified of the Final Office Action by the Office, Applicant submits that the abandonment of the instant application was due to errors on the part of the Office.

Applicant therefore respectfully requests timely withdrawal of the holding of abandonment. Applicant further respectfully requests the Office process the POA and resend the Final Office Action to the attorneys of record, MBHB, to permit the attorneys of record time to file a proper response to the Final Office Action.

The Office is invited to call the undersigned at (312) 913-3338 as necessary to discuss this petition.

Respectfully submitted,

**McDONNELL BOEHNEN
HULBERT & BERGHOFF LLP**

Dated: September 11, 2009

By: /Thomas J. Loos/
Thomas J. Loos
Reg. No. 60,161